

REMARKS

I. Introduction

Claims 14 to 26 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable. Reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all of the certified copies of the priority documents have been received.

II. Rejection of Claims 14 to 16, 18 to 20, 23 and 24 Under 35 U.S.C. § 102(b)

Claims 14 to 16, 18 to 20, 23 and 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,662,255 (“Garrett”). For at least the following reasons, Applicants respectfully submit that Garrett does not anticipate the presently pending claims.

Claim 14, as presented, relates to a hand-held locating device for detecting an object enclosed in a medium, comprising, in relevant part, a housing having an opening penetrating therethrough, the opening configured to accommodate a device for marking a surface of the medium. Support for this amendment may be found, for example, at page 3, lines 16 to 22 of the Specification. As indicated in the Specification on page 3, the opening may be used, for example, to guide a pencil or similar marking systems for a marking to be left on the surface of the medium to be examined. Garrett does not disclose, or even suggest, an opening configured to accommodate a device for marking a surface of a medium.

The Office Action refers to items 32, 32a and 50a of Figures 1 and 9 of Garrett as disclosing this feature. It is evident from Figure 1 of Garrett, however, that the space within the outer inductor assembly 32 of Garrett, is not configured to accommodate a marking device. The space is relatively large, and does not provide any manner of accurate marking. Further, the outer inductor assembly is located at a relatively great distance from the hand-held portion of the device. A user would not be able to both hold the device and mark the surface of the medium. The present invention, on the other hand, provides a relatively small opening, as depicted in Figure 1, so as to more accurately allow a user to mark the surface of the medium being analyzed.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki*

Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Garrett does not disclose, or even suggest, an opening that is configured to accommodate a device for marking a surface of the medium. As such, Garrett does not disclose, or even suggest, each and every feature of claim 14, as presented, and therefore Garrett does not anticipate claim 14.

Claims 15, 16, 18 to 20, 23 and 24 depend from claim 14 and therefore include all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, each and every feature of claim 14, as presented. As such, Garrett does not anticipate independent claim 14 or dependent claims 15, 16, 18 to 20, 23 and 24.

Withdrawal of the present rejection is respectfully requested.

III. Rejection of Claims 14 and 26 Under 35 U.S.C. § 102(e)

Claims 14 and 26 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2006/0062472 (“Engelberg”). For at least the following reasons, Applicants respectfully submit that Engelberg does not anticipate the presently pending claims.

Engelberg does not disclose, or even suggest, an opening, penetrating through a housing, configured to accommodate a device for marking a surface of a medium. The Office Action refers to a vehicle as the housing of the present application, and to the interior compartment of the vehicle as the opening of the present invention. The interior compartment of the vehicle, however, is not configured to accommodate a device for marking a surface of the medium being examined. The interior compartment is just that; an interior compartment. It could not be configured to mark any medium. It is an enclosure, in which the occupants of a vehicle reside during the use of the vehicle. It is not the opening of claim 14.

Further, the compartment of the vehicle of Engelberg is not penetrating, as featured in claim 14. The compartment of Engelberg is a cavity; it is an enclosure for the users of the vehicle to occupy during the use of the vehicle. There is no penetrating aspect of the compartment.

Further still, the Office Action refers to the compartment as disclosure of the opening of claim 14 and the vehicle as the housing of claim 14 while referring to the interior of the vehicle as the medium of claim 14. This would imply that the present application is

directed towards the location of objects within the opening. In fact, the present application is directed to the location of objects within a medium that is not itself part of the claimed device. The medium being examined and the opening featured in claim 14 are not the same item, and should not be treated as such.

Engelberg is directed to a device that is wholly different from the present application. Engelberg does not disclose, or even suggest, each and every feature of claim 14, as presented. Therefore, Engelberg does not anticipate claim 14.

Claim 26 depends from claim 14 and therefore includes all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Engelberg does not disclose, or even suggest, all of the features of claim 14, and therefore does not anticipate independent claim 14 or dependent claim 26.

Withdrawal of the present rejection is respectfully requested.

IV. Rejection of Claim 17 Under 35 U.S.C. § 103(a)

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrett in view of U.S. Patent No. 4,859,931 (“Yamashita”). For at least the following reasons, Applicants respectfully submit that the combination of Garrett and Yamashita does not render unpatentable claim 17.

Claim 17 depends from claim 14 and therefore incorporates all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Yamashita does not cure the critical deficiencies of the primary reference. As such, the combination of Garrett and Yamashita does not disclose or suggest all of the features of independent claim 14 or dependent claim 17, and therefore does not render unpatentable the presently pending claim.

Withdrawal of the present rejection is respectfully requested.

V. Rejection of Claims 21 and 22 Under 35 U.S.C. § 103(a)

Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrett in view of U.S. Patent No. 6,266,006 (“Audet”). For at least the following reasons, Applicants respectfully submit that the combination of Garrett and Audet does not render unpatentable claims 21 and 22.

Claims 21 and 22 depend from claim 14 and therefore incorporate all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Audet does not cure the critical deficiencies of the primary reference. As such, the combination of Garrett and Audet

does not disclose or suggest all of the features of independent claim 14 or dependent claims 21 and 22, and therefore does not render unpatentable the presently pending claims.

Withdrawal of the present rejection is respectfully requested.

VI. Rejection of Claim 25 Under 35 U.S.C. § 103(a)

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrett in view of U.S. Patent No. 6,844,713 (“Steber”). For at least the following reasons, Applicants respectfully submit that the combination of Garrett and Steber does not render unpatentable claim 25.

Claim 25 depends from claim 14 and therefore incorporates all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Steber does not cure the critical deficiencies of the primary reference. As such, the combination of Garrett and Steber does not disclose or suggest all of the features of independent claim 14 or dependent claim 25 and therefore does not render unpatentable the presently pending claim.

Withdrawal of the present rejection is respectfully requested.

VII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: August 19, 2008

By: /Clifford A. Ulrich/
Clifford A. Ulrich, Reg. No. 42,194

for

Gerard A. Messina
Reg. No. 35,952

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646